

### **REMARKS**

Claims 1-32 are currently pending in this application, with claims 6-21 withdrawn from consideration. In order to expedite the allowance of this application, withdrawn claims 6-21 are canceled by this amendment.

Claim 1 is amended to incorporate the subject matter of claim 32, which is now canceled. Claim 2 is amended as explained below. New claims 33 and 34 are added, which depend directly or indirectly from claim 1, and which contain portions of the subject matter of canceled claims 13 and 14.

### **REJECTIONS UNDER § 112**

Claim 2 is rejected as being non-compliant with the written description requirement of § 112, first paragraph. Applicants respectfully request reconsideration.

Without conceding to the propriety of this rejection and in order to expedite prosecution, claim 2 is amended to delete unnecessary language and to further clarify the subject matter. Accordingly, Applicants respectfully submit that claim 2 is in compliance with the written description requirement of § 112, first paragraph, and request that the rejection be withdrawn.

### **REJECTIONS UNDER § 102**

#### A. Shlomo (U.S. Patent No. 6,272,371)

Claims 1, 2, 24, and 32 are rejected under § 102(b) as being anticipated by *Shlomo*. Applicants respectfully request reconsideration.

Independent claim 1 recites an apparatus comprising a catheter and “a plurality of tube wall bending indicators located at least on or within the catheter wall.”

*Shlomo* describes an invasive probe apparatus including a flexible elongate probe for insertion into a body (see Abstract). However, there is no disclosure of a “plurality of tube wall bending indicators located at least on or within the catheter wall.” For example, FIG. 4 of *Shlomo* shows a bend-responsive catheter 20 that includes piezoelectric elements 82, 84, and 86 used to sense bending in catheter 20 (see col. 8, lines 17-24). Strain gauges may be substituted for piezoelectric elements 82, 84, and 86 (see col. 8, lines 50-52). However, piezoelectric elements 82, 84, and 86 are not “located at least on or within the catheter wall,” as recited by claim 1.

Rather, piezoelectric elements 82, 84, and 86 are “mechanically coupled to resilient member 38, so that when member 38 is bent, as described above, the bending force is conveyed to and acts upon the elements” (col. 8, lines 25-28). Neither FIG. 4 nor the relevant description in *Shlomo* indicates that resilient member 38 is part of the catheter wall.

For at least these reasons, Applicants respectfully submit that the above-rejected claims are not anticipated by *Shlomo*. Accordingly, withdrawal of the rejection is respectfully requested.

B. Lundquist (U.S. Patent No. 5,228,441)

Claim 1 is rejected under § 102(b) as being anticipated by *Lundquist*. Applicants respectfully request reconsideration.

*Lundquist* has the same deficiency as *Shlomo* with respect to the “plurality of tube wall bending indicators located at least on or within the catheter wall” recited claim 1. For example, FIG. 3 of *Lundquist* shows a catheter made of a tubing 46 which contains pull wires 76 and 77. If tubing 46 is being considered to represent a catheter wall, and pull wires 76 and 77 are being considered to represent tube wall bending indicators, then pull wires 76 and 77 are not located on or within tubing 46, as would be required by claim 1.

This is made clear in FIGS. 6 and 7 of *Lundquist*, which show transverse cross-sections of the catheter of FIG. 3 taken along lines 6—6 and 7—7, respectively. FIG. 6 shows that pull wires 76 and 77 are not located on or within tubing 46. FIG. 7 shows instead that pull wires 76 and 77 are “bonded to opposite sides of the flat spring element 71” (col. 5, lines 41-43).

For at least these reasons, Applicants respectfully submit that claim 1 is not anticipated by *Lundquist*. Accordingly, withdrawal of the rejection is respectfully requested.

C. Heckele (U.S. Patent No. 5,448,989)

Claims 5 and 25-31 are rejected under § 102(b) as being anticipated by *Heckele*. Applicants respectfully request reconsideration.

The apparatus of claim 1 has a catheter that is “radiopaque under x-ray fluoroscopy.” *Heckele* describes a shaft for guiding medical instruments into body cavities (see Abstract). However, *Heckele* lacks a disclosure of a catheter that is radiopaque under x-ray fluoroscopy.

For at least these reasons, Applicants respectfully submit that claims 5 and 25-31, which

depend from claim 1, are not anticipated by *Lundquist*. Accordingly, withdrawal of the rejection is respectfully requested.

### REJECTIONS UNDER § 103

Claims 3, 4, 22, and 23 are rejected under § 103(a) as being unpatentable over *Shlomo* in view of *Moberg* et al. (U.S. Patent No. 5,628,777). Applicants respectfully request reconsideration.

As explained above, claim 1 recites an apparatus comprising a catheter and “a plurality of tube wall bending indicators located at least on or within the catheter wall.” Further, claim 1 recites that “the plurality of tube wall bending indicators provide an indication of tube wall bending.”

*Moberg* describes implantable leads incorporating accelerometer-based cardiac wall motion sensors (see Abstract). The Office Action points to the disclosure of strain gauges in *Moberg* at col. 15, lines 18-23. However, this passage in *Moberg* indicates that the strain gauges “are capable of providing signals indicative of cardiac wall motion to the implantable cardiac stimulating device.” These strain gauges do not “provide an indication of tube wall bending,” as recited by claim 1. Further, these strain gauges are not “located at least on or within a catheter wall,” as recited by claim 1.

Thus, like *Shlomo*, *Moberg* lacks a disclosure of a “plurality of tube wall bending indicators located at least on or within the catheter wall.” Thus, without conceding that *Shlomo* could properly be combined with *Moberg*, such a combination would still lack at least this feature of claim 1.

For at least these reasons, Applicants respectfully submit that the above-rejected claims, which depend from claim 1, are patentable over *Shlomo* in view of *Moberg*. Accordingly, withdrawal of the rejection is respectfully requested.

**CONCLUSION**

Applicants respectfully submit that the present application is in condition for allowance. The Examiner is invited to contact Applicants' representative to discuss any issue that would expedite allowance of this application.

The Commissioner is authorized to charge all required fees, fees under § 1.17, or all required extension of time fees, or to credit any overpayment to Deposit Account No. 11-0600 (Kenyon & Kenyon LLP).

Respectfully submitted,

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